

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1, 6, 8, and 10 will have been amended to eliminate the term "a mail from command" from the preambles of these independent claims. Applicant submits that the amendments do not impact the combinations of features recited in bodies of the claims because the bodies do not include or refer the term "a mail from command". Thus, claims 1-11 remain pending for consideration by the Examiner. The independent claims will further have been amended to enhance clarity.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejection of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicant's Claim for Priority under 35 U.S.C. § 119 and for confirming receipt of the certified copies of the priority documents (in the parent application), as set forth in the Official Action. Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2004, July 6, 2004, and March 4, 2005 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements. Applicant further thanks the Examiner for his cooperation regarding the personal interview conducted on January 27, 2005 in regard to U.S. Application No. 10/767,615.

Turning to the merits of the action, the Examiner has rejected claims 1-11 under the judicially created doctrine of obviousness-type double patenting as being

P24507.A04

unpatentable over claims 1-5 of U.S. Patent No. 6,710,894 in view of BEAK et al. (U.S. Patent No. 5,798,845).

As noted above, Applicant has amended claims 1, 6, 8, and 10 and has submitted the same for reconsideration by the Examiner. Applicant respectfully traverses the above rejection based on pending claims 1-11, and will discuss said rejection with respect to the pending claims in the present application as will be set forth herein below. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 1-11 generally relate to an image data communication apparatus connected to an image data source and to a network. The image data communication apparatus transmits image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail message. The image data is attached to the e-mail as an openable document. The image data communication apparatus includes a memory that stores default information and a panel section that inputs information regarding an identification of a user into the image data communication apparatus. The image data communication apparatus also includes a controller that sets the default information into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is not input by the panel section. Further, the controller sets the information regarding the identification of the user input by the panel section, into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is input. Then, opening, at the receiving apparatus, of the

attached image data is not required to determine the information regarding the identification of the user.

On contrary, claims of U.S. Patent No. 6,710,894 (patented parent of the present application) relate to an image data communication apparatus which sets the information regarding the identification of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached.

However, the parent patented claims do not recite a memory that stores default information. The patented claims of the parent also do not recite a controller that sets the default information into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is not input by the panel section. Further, the parent patented claims do not recite a controller that sets the information regarding the identification of the user input by the panel section, into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is input (i.e., as opposed to when the information is not input).

On the other hand, the pending claims recites a memory that stores default information. The pending claims also recite a controller that sets the default information into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is not input by the panel section. Further, the pending claims recite a controller that sets the information regarding the identification of the user input by the panel section, into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is input.

Thus, the pending claims are clearly distinguished over the patented claims of the parent application.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 1-11 are not disclosed in the claims of U.S. Patent No. 6,710,894 cited by the Examiner.

BAEK et al. relates to a facsimile system which prints a user's unique name at the top of the document received by a recipient. BEAK et al. also discloses the automatic dialing number "FF" as a default number.

However, BAEK et al. relates, not to an Internet facsimile apparatus, but to an ordinary facsimile apparatus. Thus, BEAK et al. does not disclose and thus cannot teach or render obvious at least a controller that sets the default information into the mail message of the e-mail to which the image data is attached. The BEAK et al. reference also does not disclose at least a controller that sets the information regarding the identification of the user input by the panel section, into the mail message of the e-mail to which the image data is attached.

On the other hand, the pending claims recite a controller that sets the default information into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is not input by the panel section. The pending claims also disclose a controller that sets the information regarding the identification of the user input by the panel section, into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is input.

Therefore, Applicant submits that even if one attempted to combine the claims of U.S. Patent No. 6,710,894 and the teachings of BEAK et al. in the means suggested by the Examiner, such a combination would fail to render Applicant's invention obvious, since such a combination would not include at least a controller that sets the default information into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is not input by the panel section and sets the information regarding the identification of the user input by the panel section, into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is input.

Therefore, Applicant respectfully submits that the Examiner has not set forth a proper basis for the obviousness-type double patenting rejection, since the features of the pending claims 1-11 are not disclosed or suggested by the combination of the claims of U.S. Patent No. 6,710,894 and BEAK et al.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application, in due course.

Applicant further wishes to make of record the above-noted personal interview conducted between Applicant's undersigned representative and Examiner Lee on January 25, 2005 in regard to co-pending application No. 10/767,615. The above-noted interview was attended by the undersigned representative of Applicant's assignee as well as Mr. Hiroshi Takahashi of Panasonic Communications Co., Ltd., the assignee of the present application.

Initially, Applicant wishes to thank Examiner Lee for his courtesy and cooperation in scheduling and conducting the above-noted interview. Applicant further wishes to thank the Examiner for his cooperative and positive attitude towards the interview and towards the invention defined in the present application.

During the above-noted interview, Applicant discussed the then outstanding objection and rejection in U.S. Patent Application No. 10/767,615.

During the above-noted interview, Applicant also noted for the Examiner that the present application is one of 15 continuation applications that all claim priority, under 35 U.S.C. § 120 from parent U.S. Patent Application No. 09/461,402, which is now U.S. Patent No. 6,710,894 and which issued on March 23, 2004.

Additionally, during the above-noted interview, Applicant presented the Examiner with a chart listing the 15 continuation applications and pointing out the differences between the subject matter to which the claims of each of the 15 continuations (as well as the parent) were directed. Applicant prepared and gave this chart to the Examiner to facilitate examination of all the continuation applications.

Applicant's representative also pointed out that since the subject matter of each of the applications is directed to a different aspect (or combination of aspects) of the present invention, Applicant does not believe that any type of obviousness type double patenting rejection is appropriate. However, Applicant respectfully requested that the Examiner consider the claims of all of these applications together to determine for himself whether a obviousness type double patenting rejection is appropriate. Applicant further indicated that if the Examiner decides that such a rejection is indicated, he would consider filing a Terminal Disclaimer to overcome such rejection.

As is apparent in the present application, the Examiner made an obviousness type double patenting rejection. However, in response, Applicant is not filing a Terminal Disclaimer but is traversing the presently asserted rejection.

Additionally, during the above-noted interview, Applicant's representative discussed several of the documents cited in the Information Disclosure Statements filed in the present application. In this regard, Applicant noted and expressly directed the Examiner's attention to Japanese Laid-Open Patent Publication HEI 10-307769, that issued to the Assignee of the present application and to Japanese Laid-Open Patent Publication HEI 08-542326 to Matsushita Electric Industrial Co., Ltd.

Applicant pointed out that both of these documents relate to the general subject matter of returning an error message which is claimed in several of the co-pending and commonly assigned continuation applications discussed above.

An English language translation and an English language patent family member of the above-noted Japanese documents (filed together with the Information Disclosure Statement) were also brought to the Examiner's attention and portions of the English language translation and patent family member were noted to relate to return of an error message. The Examiner particularly noted the portions of the translation and family member that discuss the feature of returning an error message.

Applicant further respectfully suggested that in view of the discussion of the subject matter of various ones of the continuation applications, it would be obviously efficient to conduct examination of these 15 applications within a short time period after the interview in the present application.

P24507.A04

At the conclusion of the interview, Applicant's undersigned representative expressed his appreciation to the Examiner for taking the time out of his busy schedule to conduct an extensive interview regarding the present application as well as regarding the co-pending applications. Applicant again thanks the Examiner for his courtesy as well as for his positive and cooperative nature, as exhibited during the above-noted interview.

SUMMARY AND CONCLUSION

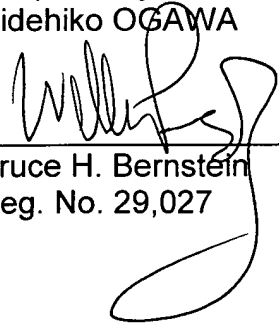
Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims without narrowing the scope thereof for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and how they are distinct from the claimed subject matter of the parent as proposed to be modified by the Examiner. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

June 30, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Respectfully submitted,
Hidehiko OGAWA



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630